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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/479,210	06/07/95	BEDNORZ J	YO987-074BY

11M1/0212

IBM CORPORATION
INTELLECTUAL PROPERTY LAW
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EXAMINER	
MC GINTY, D	
ART UNIT	**PAPER NUMBER**
1105	

DATE MAILED: 02/12/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/479,810	Applicant(s) Bednorz et al.
	Examiner Douglas J. McGinty	Group Art Unit 1105

☒ Responsive to communication(s) filed on *Jun 3, 1996* .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *0* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-108* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *1-108* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   a. Group I: Claims 1, 12-31, 33-38, 40-46, 55-59, 64, 69-72, 77-81, 84-86, 91-96, and 103, drawn to the apparatus, classified in Class 505, subclass 825.

   b. Group II: Claims 2-11, 32, 39, 47-54, 60-63, 65-68, 87-90, 97-102, and 104-108 drawn to the compound or composition, classified in Class 423, subclass 604, or Class 252, subclass 521.

   c. Group III: Claims 73-76, 82, and 83, drawn to a method of making a superconductor, classified in Class 505, subclass 725.

2. The inventions are distinct, each from the other because of the following reasons:

   a. Inventions II and I are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a diamagnetic material used for bulk levitation and the inventions are deemed to be patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

   b. Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the

process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process can be used to make a materially different product such as a bulk diamagnetic material used for levitation.

c. Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as sputtering.

d. Because these inventions are distinct for the reasons given above and have acquired separate stati in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

e. Because these inventions are distinct for the reasons given above and have acquired separate stati in the art because of their recognizedly divergent subject matters, restriction for examination purposes as indicated is proper.

3. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Suggestions for advancing prosecution

5. The above restriction requirement was constructed in view of the literal language in the present claims. It is noted, however, that the claims contain a multitude of problems under 35 USC 112. For instance, claim 2 refers to "(t)he composition of claim 1, whereas claim 1 recites an "apparatus". The following changes are thus suggested:

   a. Amend claims 2-11 to follow the format: -- The apparatus of claim __, wherein said composition --.

   b. In claim 39, change "composition" to --combination--.

   c. Change claim 47 to read: --The apparatus of claim 46, wherein said metal is Cu.--

   d. In claim 87, change "method" to --apparatus--.

   e. In claims 97-102 and 103-108, change "superconductive method" to --superconductor apparatus--.

6. The prosecution history of this case has been reviewed again. Apparently, the applicants now intend to prosecute the apparatus claims which were non-elected in an ancestral application. See paper nos. 20 (August 8, 1990), 22 (February 13, 1991), and 24 (April 25, 1991) in 07/053,307. To further that apparent intent, therefore, it is suggested that the following claims be canceled without prejudice as not directed to the apparatus claims discussed above:

   a. Claims 48-54, 60-63, and 65-68 should be canceled as directed to the composition.

   b. Claims 73-76, 82, 83, and 88-90 should be canceled as directed to the method of making.

7. If the above suggestions are **CAREFULLY** followed, the response to this Restriction requirement will be fully responsive, since only apparatus claims will remain thereafter. See MPEP 818.02(c). That Response also should explicitly indicate that such an election has been made.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. McGinty, whose telephone number is (703) 308-3805. The examiner normally can be reached on Monday through Friday from 8:30 A.M. to 5:00 P.M., Eastern time. If *reasonable* attempts to reach the examiner by telephone are unsuccessful, however, the examiner's supervisor, Mr. Paul Lieberman, can be reached at (703) 308-2523. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661. The fax number for this Group is (703) 305-3600.

February 11, 1997
479810.1

Douglas J. McGinty

Douglas J. McGinty
Primary Examiner
Group 1100